

**REMARKS/ARGUMENTS**

In response to the Office Action dated September 26, 2003, claim 34 is amended. Claims 1-36 are now active in this application. No new matter has been added.

The indication that claims 4, 5, 8, 9, 15, 16, 19, 20, 26, 27, 30 and 31 would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims is acknowledged and appreciated.

**REJECTION OF CLAIMS UNDER 35 U.S.C. § 102 AND § 103**

I. Claims 1, 12 and 23 are rejected under 35 U.S.C. § 102(e) as being anticipated by Kuno et al. (USPN 6,538,242).

The rejections are respectfully traversed.

Anticipation, under 35 U.S.C. § 102, requires that each element of the claim in issue be found, either expressly described or under principles of inherency, in a single prior art reference. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983).

Kuno et al. discloses a method of measuring spectral responsivity characteristic of an image pick-up device. The respective colors in the test chart in Kuno are known (see column 1, lines 44-45). Accordingly, the arrangement of the inventions recited in claims 1, 12 and 23 is different from the arrangement of Kuno in that color values of the respective color samples in the test chart are calculated in the present invention (calculates a color value of each color sample using the extracted image signal). Kuno et al. does not disclose “calculating a color value of each color sample”, as recited in each of independent claims 1, 12 and 23.

Claim 12 also recites:

an image processor which extracts image signals corresponding to color samples *based on* the taken test chart image and *information on section division*, and calculates a color value of each color sample using the extracted image signal.

Kuno et al. does not disclose extracting image signals corresponding to color samples *based on .... information on section division*, as recited in claim 12.

Claim 23 recites:

a color image taking apparatus which takes up *a color image of a test chart in which* specified color samples are respectively arrayed in sections divided in a matrix manner and *a marker indicating a boundary of sections are provided* to output image signals of a plurality of color components...

Kuno et al. does not disclose a test chart in which ... *a marker indicating a boundary of sections* are provided, as recited in claim 23.

These differences between the claimed device vis-à-vis the device of Kuno et al. undermine the factual determination that Kuno et al. identically describes the claimed inventions within the meaning of 35 U.S.C. § 102. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986).

Therefore, withdrawal of the rejection of claims 1, 12 and 23 under 35 U.S.C. § 102 as being anticipated by Kuno et al., as well as their allowance, are respectfully solicited.

II. Claims 2, 3, 6, 7, 10, 11, 13, 14, 17, 18, 21, 22, 24, 25, 28, 29, 32 and 33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kuno et al. in view of Yamaguchi et al. (USPN 5,963,334).

The rejections are respectfully traversed.

Claims 2, 3, 6, 7, 10 and 11 depend from independent claim 1, claims 13, 14, 17, 18, 21 and 22 depend from independent claim 12, and claims 24, 25, 28, 29, 32 and 33 depend from independent claim 23. As independent claims 1, 12 and 23 are patentable over Kuno et al., dependent claims 2, 3, 6, 7, 10, 11, 13, 14, 17, 18, 21, 22, 24, 25, 28, 29, 32 and 33 are patentable over Kuno et al. also, even when consider in view of Yamaguchi et al.

**III.** Claims 34-36 are rejected under 35 U.S.C. § 102(b) as being anticipated by Rollerston et al. (USPN 5,416,613).

The rejection of claims 35 and 36 are respectfully traversed.

i. Claim 35 recites, *inter alia*:

an image processor which *extracts image signals* corresponding to color samples *based on* the taken test chart image *and information on section division*, and calculates a color value of each color sample using the extracted image signal...

Rollerston et al. does not disclose extracting image signals corresponding to color samples *based on information on section division*.

Claim 36 recites, *inter alia*:

an image processor which *extracts image signals* corresponding to color samples *based on markers in the taken test chart image*, and calculates a color value of each color sample using the extracted image signal...

Rollerston et al. does not disclose extracting image signals corresponding to color samples *based on markers in the taken test chart image*.

These differences between the claimed device vis-à-vis the device of Rollerston et al. undermine the factual determination that Rollerston et al. identically describes the claimed inventions within the meaning of 35 U.S.C. § 102. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc., supra; Kloster Speedsteel AB v. Crucible Inc., supra.*

Therefore, withdrawal of the rejection of claims 35 and 36 under 35 U.S.C. § 102 as being anticipated by Rollerston et al., as well as their allowance, are respectfully solicited.

ii. To expedite prosecution, independent claim 34 is amended to recite:

a color image taking apparatus which simultaneously takes up a plurality of color images of the test chart to output image signals of a plurality of color components...

Whereas Rollston et al. discloses that the test chart is scanned, Rollston et al. does not disclose that the color image taking apparatus simultaneously takes up a plurality of color images of the test chart. Thus, amended independent claim 34 is patentable over Rollston et al.

## CONCLUSION

Accordingly, it is urged that the application, as now amended, is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper,

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including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "Edward J. Wise", written in a cursive style.

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